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Petitioner  
37 CFR  
1.181  
DW

P96005US2B(P260)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of

DONALD R. RUSSELL and  
JOSEPH J. KALWARA

Serial No. 09/505,052

Filed February 16, 2000

For SELF-ADHERING WALKWAY PADS  
FOR ROOFING MEMBRANES AND  
METHOD FOR THE APPLICATION  
THEREOF TO ROOFS

Group Art Unit 3635

Y. Horton, Examiner

JAN 28 2002

## CERTIFICATE OF FACSIMILE

I hereby certify that this correspondence was forwarded  
via facsimile to Facsimile No. 703-872-9327, Assistant  
Commissioner for Patents, Washington, D.C. 20231 on  
January 28, 2002

GROUP 3600

  
Kimberly A. Bright, Secretary to Arthur M. Regine

## PETITION CONTESTING THE ISSUANCE OF A FINAL REJECTION

ATTN: Technology Center Director 3635  
ASSISTANT COMMISSIONER FOR PATENTS  
Washington, D.C. 20231

Sir

Applicants hereby petition to invoke the supervisory authority of the Commissioner under 37 C.F.R. 1.181 to review the *ex parte* Action of the Examiner in declaring the latest Office Action in the subject application to be final. Applicants believe that the finality of the latest Office Action is inappropriate and therefore premature. M.P.E.P. § 1002.02(c).

The Manual of Patent Examining Procedures sets forth that a second or subsequent Action on the merits shall be final except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an Information Disclosure Statement filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p). M.P.E.P. § 706.07(a).

The Examiner admits at paragraph 17 of the final Office Action that "Applicants' arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection." Indeed, each of the Examiner's rejections under 35 U.S.C. §§ 102 and 103 are based, at least in part, on U.S. Patent No. 3,903,340. This patent reference was not the subject of any earlier rejection.

This "new ground(s) of rejection" was not based upon an Information Disclosure Statement. And, Applicants do not believe that the new ground of

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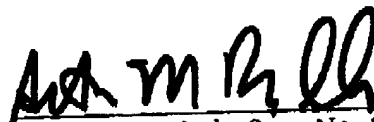
rejection was necessitated by Applicants' previous amendment. Indeed, the amendments made to claim 1 in the Response dated July 12, 2001, were made merely to better define the invention although no new structure or method steps were added. Specifically, Applicants removed the phrase "prior to use in the field, the opposite side of said tape carrying a protective layer of release paper" and substituted therefore the phrase "where the tape carries a protective layer of release paper and where said step of affixing occurs at the location where the pad is manufactured."

Applicants believe that the prematureness of the final rejection will prejudice the Applicants by not allowing them the opportunity to adequately address the shortcomings of U.S. Patent No. 3,903,304, which was recently discovered by the Examiner, as well as the shortcomings of the Examiner's rejections based thereon.

Applicants note that the undersigned counsel attempted to handle this matter via a telephone call, but attempts to contact the Examiner were not successful.

Favorable consideration on this Petition is respectfully requested. Should the Commissioner care to discuss any of the foregoing in greater detail, the undersigned attorney welcomes a phone call. No fee is believed due with the filing of this Petition, but in the event that a fee is due, the Commissioner is authorized to charge Deposit Account No. 06-0925 for the fee. Applicants also note that this Petition is being filed contemporaneously with a Response to the final Office Action.

Respectfully submitted,



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January 28, 2002

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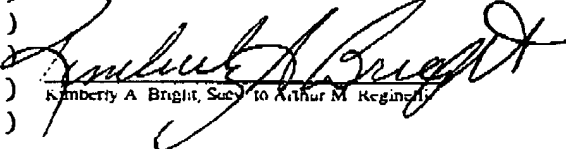
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Kimberly A. Bright, Secretary to Arthur M. Reginelli**Total Number of Pages: 3**

If you do not receive all pages, please notify Kimberly at 330-761-6660 as soon as possible.

**TRANSMITTAL SHEET****FAX RECEIVED**

Enclosed are the following documents:

JAN 28 2002

Petition Contesting the Issuance of a Final Rejection  
Return Receipt Postcard**GROUP 3600****AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

The Commissioner is hereby authorized to charge payment of any fees associated with this communication or credit any overpayment to Deposit Account No. 06-0925.

Respectfully submitted,



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